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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,792	01/15/2002	W Thomas Urmson, Jr.	2046-011632	7034

7590 03/16/2004

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Pittsburgh, PA 15219-1818

EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/937,792

Applicant(s)

URMSON, JR. ET AL.

Examiner

Timothy P McAnulty

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-23, 27, and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Numbering/Pending Claims***

1. Claims 29-32 were first presented in the amendment filed 16 October in Paper No. 12. Paper No. 12 was filed after the Final rejection mailed 09 October 2003 and was accordingly treated as an after-final amendment. Claims 29-32 were not entered as indicated in the Advisory action mailed 14 November 2003.

The Request for Continued Examination (RCE), filed 09 February 2004 in Paper No. 16 indicated the submission, as required by 37 CFR 1.114 was enclosed, i.e. was not previously submitted in an after-final amendment. The listing of the claims in Paper No. 16 correctly indicated claims 29-32 as "not entered." Accordingly, claims 29-32 are not currently pending in the application. If applicant wants those limitations set forth in claims 29-32 considered, those limitations must be rewritten in "newly presented" claims with claim numbering beginning at claim number 33.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 9,10,12-17,19-23,27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Watts.

Watts discloses in figures 1-3 an applicator bar for applying a material to a head of a rail comprising a body 3 having a flow passageway therein, said flow passageway defining an exit 5; a dam sealed by an elastomeric member 17 and said body 3; a metal distribution blade 8; and a flexible skirt 9, enclosing an upper portion of said dam. Watts further discloses in lines 10-29, a pump and reservoir in fluid communication with said flow passageway.

*Claim Rejections - 35 USC § 103*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Huck (US Patent No. 2,489,182).

Regarding claims 4 and 11, Watts discloses the basic apparatus as previously cited but does not disclose said skirt made from an elastomeric material. However, Huck teaches in figure 1 and lines 23-64 of column 3, a railway track lubricating device comprising a flexible skirt member B made from an elastomeric material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to include a skirt made from an elastomeric material to provide a skirt having increased resiliency.

Regarding claim 18, Watts discloses the basic apparatus as previously cited but does not disclose said skirt position over a portion of the upper surface of said rail. However, Huck in figure 1, teaches a railway track lubricating device comprising a flexible skirt position over a portion of the upper surface of a rail. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to position said skirt over a portion of the upper surface of a rail so as to provide an increased amount of lubrication material to an upper surface of said rail.

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***Allowable Subject Matter***

6. Claims 1-8 are allowed.

The prior art discloses the basic apparatus as previously cited but does not disclose said material contained on an upper surface of a rail, i.e., the dam creates a reservoir of material atop the rail.

***Response to Arguments***

7. Applicant's arguments filed 09 February 2004 have been fully considered but they are not persuasive. Watts discloses an applicator for applying material to a rail, wherein the distribution blade has openings 11 for directing material to the rail from a reservoir contained below the railhead.

Regarding claims 9-13,22,27, and 28, the limitation “for directing material *to* a crown of the rail” (emphasis added) does not limit the claimed invention such that the material is contained on the upper surface of the rail. As such the limitation is disclosed by Watts.

Regarding claims 14-21, the limitation that an applicator applies “material *to* the upper surface of the rail” (emphasis added) is not narrowly construed to require the material is applied *on* the upper surface of the rail. As such the limitation is disclosed by Watts.

Regarding claim 23, the limitation that an applicator applies material to a head of a rail and for “directing the material *to a crown* of the rail” is broadly construed to include any part of the crown, i.e. the crown is not only the upper surface of the railhead. Furthermore, the limitation merely requires material applied *to* a crown and does is not narrowly construed to require material applied on the upper surface of the rail.

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*Conclusion*

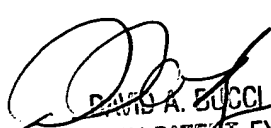
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm

11 March 2004

  
DAVID A. BUCCI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600  
3/15/04